



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,076	11/26/2003	Hiroo Okamoto	62758-066	4159

7590 04/01/2005

MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
----------

AGWUMEZIE, CHARLES C

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/722,076

Applicant(s)

OKAMOTO ET AL.

Examiner

Charlie C. Agwumezie

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/26/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

12

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-6, 8-20,** are rejected under 35 U.S.C. 102(b) as being anticipated by Teruhiko European Patent Application EP 1 085 740 A2.

1. As per **claim 1**, Teruhiko discloses a receiving apparatus, for receiving digital information, thereby outputting it into a printer, comprising:

a receiving circuit for receiving said digital information (fig. 1 and 3; col. 28, lines 35-43);

an extractor circuit for extracting static image information from said digital information (fig. 1);

a recording/reproducing circuit for recording therein the static image information extracted (fig. 8 and 10; col. 30, lines 40-45, 55+); and

an output circuit for outputting the static image information reproduced from said recording/reproducing circuit, with adding copy control information thereto, as information being able to control printing of said printer (fig. 5 and 8; col. 31, lines 10-

25).

2. As per **claim 2**, Teruhiko discloses the receiving apparatus, further comprising: a converter circuit for converting said static image information into data for use in printing, wherein said output circuit adds the copy control information to said data for use in printing, so as to output it (fig. Fig. 9; col. 35-43, 45-50, 54-58).

3. As per **claim 3**, Teruhiko further discloses the receiving apparatus, wherein said output circuit scrambles said static image information depending upon the copy control information, so as to output it (fig. 4).

4. As per **claim 4**, Teruhiko further discloses the receiving apparatus, wherein said digital information is digital image information (fig. 9; col. 6, lines 54+).

5. As per **claim 5**, Teruhiko discloses a printer for printing digital information inputted, comprising:

an input circuit for inputting said digital information (fig. 1; col. 12, lines 15-22);

a printer circuit for printing said digital information inputted (col. 2, lines 38-44);

and a control circuit for detecting copy control information added to said digital information, thereby to perform printing in said printer circuit depending upon the copy control information detected (col. 2, lines 42-48).

6. As per **claim 6**, Teruhiko further discloses the printer, wherein said control circuit makes control so that the printing is conducted when said copy control information permits a copy thereof, while the printing is not conducted when it does not permits the copy thereof (fig. 2; col. 2, lines 42-48).

8. As per **claim 8**, Teruhiko discloses a printing control method, for controlling printing of digital information, comprising the following steps of:

detecting copy control information, which is added to said digital information (fig. Fig. 1 and 2; col. 2, lines 40-45); and

controlling on whether conducting or not the printing of said digital information depending upon said copy control information detected (fig. 2, col. 2, lines 40-47, col. 3, lines 1-8, col. 5, lines 1-15, col. 6, lines 15-20).

9. As per **claim 9**, Teruhiko further discloses the printing control method, wherein the printing is conducted when said copy control information permits a copy, while it is not conducted when not permitting the copy (fig. 2 and 3; col. 3, lines 10-20).

10. As per **claim 10**, Teruhiko further discloses the printing control method, wherein no data for use in printing is outputted when said copy control information does not permit the printing (fig. 2; col. 3, lines 15-20, 40-49, col. 7, lines 30-40).

11. As per **claim 11**, Teruhiko further discloses the printing control method, wherein

Art Unit: 3621

it is informed to a user that said digital information cannot be printed out, when said , copy control information does not permit the printing (col. 3, lines 23-30).

12. As per claim 12, Teruhiko further discloses the printing control method, wherein transmission of print data in the printing of said digital data is conducted by "move" thereof (col. 5, lines 23-25).

13. As per claim 13, Teruhiko further discloses the printing control method, wherein the printing is performed when said copy control information is either one of "Copy Free", "Copy One Generation" and "No More Copy", allowing the "move", on the other hand the printing is not performed when it is "Copy Never" not allowing the "move" (col. 5, lines 32-39).

14. As per claim 14, Teruhiko further discloses the printing control method, comprising a contemporary buffer for use of printing, a print screen selecting means, and means for initiating said print screen selecting means, wherein a print screen is selected from the digital information stored in said temporary buffer for use of printing by means of said print screen selecting means fig. 3 and 6; col. 10, lines 32-45).

15. As per claim 15, Teruhiko further discloses the printer, wherein said control circuit deletes the digital information stored within the printer, when the printing is completed without generating an abnormality during the printing (col. 15, lines 10-14,

Art Unit: 3621

col. 16, lines 45-52).

16. As per **claim 16**, Teruhiko further discloses the printer, wherein said control circuit prints out the digital information stored within the printer, again, when an abnormality generates during the printing (col. 16, lines 45-52, col. 17, lines 1-5).

17. As per **claim 17**, Teruhiko further discloses the printer, further comprising a display circuit for indicating on whether the printing is completed normally or not, wherein said display circuit displays that the printing is failed when the printing is failed (col. 11, lines 12-15).

18. As per **claim 18**, Teruhiko further discloses the printer, wherein said control circuit makes setting on whether the printing should be done or not, again, depending upon a user input conducted to the input circuit, which is made responding to display by means of the display circuit (col. 5, lines 1-7, 30-39).

19. As per **claim 19**, Teruhiko further discloses the printer, wherein said control circuit informs that the printing is failed, to a digital apparatus, which outputs the print data, when the printing is failed (fig. 4, col. 11, lines 12-13).

20. As per **claim 20**, Teruhiko further discloses the receiving apparatus, further

Art Unit: 3621

comprising a display circuit for indicating a print failure message when receiving information of print failure from the printer (fig 4, col. 11, lines 12-13).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 7**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Teruhiko European Patent Application EP 1 085 740 A2 in view of Yoneda et al U.S. Patent Application Publication 2002/0056115.

7. As per **claim 7**, Teruhiko failed to explicitly disclose the printer, wherein the digital information is scrambled, and said input circuit performs de-scrambling on the information inputted with scrambling thereon.

Yoneda et al discloses the printer, wherein the digital information is scrambled, and said input circuit performs de-scrambling on the information inputted with scrambling thereon (0006).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Teruhiko and provide the printer, wherein the digital information is scrambled, and said input circuit performs de-



Art Unit: 3621

scrambling on the information inputted with scrambling thereon in view of the teachings of Yoneda et al in order to ensure that meaningful information is printed.

### ***Conclusion***

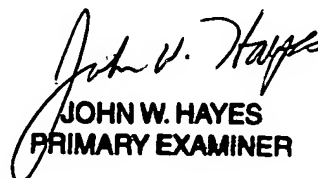
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is (703) 305-0586. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305 – 9768. The fax phone number for the organization where the application or proceeding is assigned is (703) 305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

acc  
March 21, 2005

  
**JOHN W. HAYES**  
**PRIMARY EXAMINER**